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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,223	10/28/2003	Perriann M. Holden	810101-3	4944
33651	7590	02/24/2005		
JERRY RICHARD POTTS 3248 VIA RIBERA ESCONDIDO, CA 92029			EXAMINER HOEY, ALISSA L	
			ART UNIT 3765	PAPER NUMBER

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/695,223	HOLDEN, PERRIANN M.	
	<b>Examiner</b> Alissa L. Hoey	<b>Art Unit</b> 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 18 December 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4)  Claim(s) 1,4,5 and 13-21 is/are pending in the application.  
4a) Of the above claim(s) 4,19 and 20 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1,5,13-18 and 21 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date . . . .  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 4, 19 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected protective shell embodiment, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/18/04.

***Specification***

2. The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

3. The disclosure is objected to because of the following informalities: page 1, lines 49 and 50 should the term "th" read "the"?

Appropriate correction is required.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "a layer of either hook and piles secured to the bottom surface for providing it with a textured finish" from claim 1 needs to be found in the specification.

***Double Patenting***

5. Claims 1, 5, 13 and 15-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S.

Patent application No. 10/454,236 and 09/910,641. Although the conflicting claims are not identical, they are not patentably distinct from each other because.

In regard to claim 1, both 10/454,236 and 09/910,641 teach a decorative and disposable fashion wear for the body parts that also protects the decorated body parts from abrasion. A flexible pad having a top surface and a bottom surface and a reusable adhesive material on the top surface for removably securing the pad to a body part. A removable layer covering the adhesive material and a layer of either hooks or piles secured to the bottom surface for providing it with a textured finish (claims 1, 3 and 6 in both applications). The pads of 10/454,236 and 09/910,641 are capable of being provided in a novelty kit.

In regard to claim 5, both 10/454,236 and 09/910,641 teach the material selected form cushioning, magnetic, and gel disposed in the pad between the top surface and the bottom surface (claim 5).

In regard to claim 13, both 10/454,236 and 09/910,641 teach the pad being sufficiently flexible to conform to the contour of a users selected body part consisting of a group of body parts selected from the feet, toes, knees and elbow or a user to provide protection for the body part selected. The pad of 10/454,236 and 09/910,641 are capable of conforming to user's hands and fingers as desired (claim 4 and 7).

In regard to claim 15, both 10/454,236 and 09/910,641 teach a pad that is trimmable and disposable after use (claims 1 and 2).

In regard to claim 16, both 10/454,236 and 09/910,641 teach a top surface including decorative indicia selected from the group consisting of color, patterns, messages, trademarks and advertisements (claim 2).

In regard to claim 17, both 10/454,236 and 09/910,641 teach a pad that has a body protecting material disposed between its top and bottom surfaces (claim 6).

In regard to claim 18, both 10/454,236 and 09/910,641 teach a body protecting material being selected from a cushioning, a magnetic material and a gel material (claims 5).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 13-18 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Sullivan (US 6,255,553).

In regard to claim 1, Sullivan teaches a decorative and inherently disposable fashion wear (10) for the body parts that also is capable of protecting the decorated body parts from abrasion. A flexible pad (10) having a top surface (22) and a bottom surface (26) and a reusable adhesive material (22) on the top surface for removably securing the pad (10) to a body part. A layer of either hooks or piles secured to the

bottom surface (26) for providing it with a textured finish (column 3, lines 6-23). The decorative device (10) of Sullivan is capable of being provided in a novelty kit. Further, it is inherent that the adhesive material (22) would have a removable covering layer so that the adhesive would not stick to everything it came into contact with before using.

In regard to claim 5, Sullivan teaches the material selected from cushioning (12) disposed in the pad between the top surface (26) and the bottom surface (22).

In regard to claim 13, Sullivan teaches the pad (10) being sufficiently flexible to conform to the contour of a user's selected body part consisting of a group of body parts selected from the hands, fingers, feet, toes, knees and elbow or a user to provide protection for the body part selected (column 1, lines 23-34).

In regard to claim 14, Sullivan teaches the pad being selected from a group of materials consisting of rubber, fabric, paper, plastic, synthetic materials, leather and polyurethane foam (column 2, lines 49-60).

In regard to claim 15, Sullivan teaches a pad that is capable of being trimmable and disposable after use (column 2, lines 49-60).

In regard to claim 16, Sullivan teaches a top surface including decorative indicia selected from the group consisting of color, patterns, messages, trademarks and advertisements (figures 1 and 2, identifier 26: column 3, lines 6-23).

In regard to claim 17, Sullivan teaches a pad (10) that has a body protecting material (12) disposed between its top (26) and bottom surfaces (22).

In regard to claim 18, Sullivan teaches a body protecting material being a cushioning material (column 2, lines 49-60).

In regard to claim 21, Sullivan teaches an adhesive that is skin compatible and it is inherent that a skin compatible adhesive is non irritating to the user's skin (column 2, lines 63-65). Further, it is inherent that the decorative device of Sullivan can be reused after the first application.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Morgan, Burke, Lipa, Dunshee, Maranville, Marchese, Lyons, Nathanson, Berry, Tollini, Strong, Overseth, Engel, Hanes, Gamble, Gueret, Legendre, and Jean-Louis are all cited to show closely related articles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (571) 272-4985. The examiner can normally be reached on M-F (8:00-5:30)Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (571) 272-4983. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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